



Intellectual Property

December 10 2019

Beware of Trademark Scams: Warning Signs for Trademark Owners

Trademark scams are on the rise. Over the past year, Sullivan has seen a significant increase in the number of clients who have received misleading solicitations and invoices relating to their trademarks. Every brand owner—from individuals and startups to Fortune 500 companies—is a potential target for trademark scammers and must be vigilant to guard against them. This advisory provides a brief overview of the types of misleading notices brand owners may encounter and five tips to avoid falling into traps.

Types of Scams

Private companies unaffiliated with the United States Patent and Trademark Office (“USPTO”), the official governmental registry for trademarks in the United States, are using publicly available information from USPTO databases to send trademark solicitations by mail and email to owners of trademark registrations and applications. These agencies go to extensive lengths to project the appearance of legitimacy, when in fact they are engaged in deceptive activity.

For instance, these companies may purport to offer legal services, such as assistance with trademark maintenance, office action responses or renewal filings. Some offer registration of marks in private, non-governmental databases. Many of these solicitations are official-looking documents that request immediate action and payment, and the companies behind these schemes operate under names and acronyms that suggest they are governmental bodies, using terms like “Trademark,” “Registration,” “Office,” “Agency,” etc. Without more, an invoice’s formal appearance should not be viewed as an indication of its legitimacy.

Often, these solicitations create a sense of urgency on the part of the trademark owner. Our clients have received alarming notifications that their trademark registrations are about to expire unless they pay large sums of money to these organisations to ensure renewal. Frequently, the solicitations will use dates that are incorrect. For example, we have seen scammers state that maintenance filings are due a year before the actual deadlines, implying that the first day of a one-year maintenance filing period is the final deadline. Trademark owners, understandably concerned about these types of notifications, may have the instinct to pay these fees without question. However, brand owners are never required to use any service or respond to payment demands solicited by these agencies to maintain the validity of their marks and should disregard any notice not from official governmental registries.

Trademark owners with global portfolios of marks must be specially attuned to the issue of misleading solicitations. This is a global issue, and our colleagues in Europe and around the world have reported a significant increase in the frequency of these types of notifications. U.S. clients, who may be less familiar with the formalities required for registration in foreign jurisdictions, are particularly vulnerable to deception.


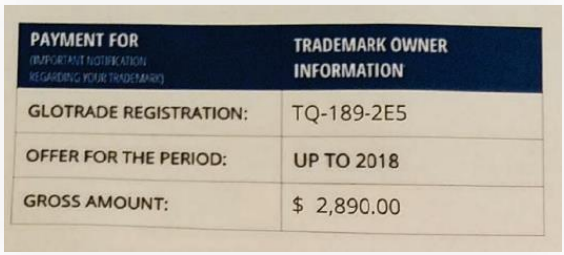


Several major official registries, including the USPTO, the European Union Intellectual Property Office (“EUIPO”), and the World Intellectual Property Office (“WIPO”), have compiled databases of known scams to warn trademark owners. Though not exhaustive, as these unofficial agencies often change their names and addresses, the links below provide a useful overview of the type and scope of misleading notices currently facing brand owners:

USPTO	https://www.uspto.gov/trademarks-getting-started/caution-misleading-notices
EUIPO	https://euipo.europa.eu/ohimportal/en/misleading-invoices
WIPO	https://www.wipo.int/pct/en/warning/pct_warning.html

Unfortunately, there has been little government enforcement against the purveyors of these misleading notices, who have continued to operate unabated. As a result, trademark owners must remain vigilant.

How to Identify a Scam

Misleading trademark solicitations come in many forms, but they tend to have a few common characteristics as outlined below:

Warning Signs	Examples
<p>1. Notifications that are not from the USPTO, EUIPO or WIPO, but use official-sounding names that include some combination of “United States,” “Trademark,” “Office,” “Brand,” “Registration,” “Agency” or the like.</p>	
<p>2. Invoices that charge astronomical or irregular fees that you have not previously encountered for the continued protection of your trademark.</p>	
<p>3. Invoices that arrive around the same time as legitimate notices and use demanding language to create a sense of urgency.</p>	
<p>4. Invoices that originate from a foreign address or include instructions for making payments to a foreign bank.</p>	

<p>5. Invoices that include fine print language like “this is not an invoice but a solicitation without an obligation to pay” or note that the continued protection of your mark is for registration in a private or proprietary database and not as part of a governmental program.</p>	<p>Please return this document with your signature and/or company stamp in the appropriate space if you would like to renew your trademark. Your trademark will be renewed for the period of another ten (10) years. The renewal fee is \$1650 for one class and \$850 for each additional class for the whole period of ten (10) years. You will receive an invoice from us after we have received this signed document from you. By signing this document you place an order for filing and automatically empower Patent & Trademark Office to renew the trademark stated above on your behalf. This order is optional and only acts as a reminder. Patent and Trademark Office is a private service company within the intellectual property area that reminds companies when their trademarks are due for the renewal. Patent and Trademark Office is non-governmental company and is not connected to any of the governmental organizations. You may also contact your legal representative to perform the renewal for you. If you have any questions regarding your trademark maintenance process, please contact us via e-mail: info@patentandtrademarkoffices.us or telephone/fax 202 888 3223. www.patentandtrademarkoffices.us</p>
<p>6. Invoices that include typos, grammar or spelling mistakes, fake URL links, or any link that leads to any website other than USPTO.GOV., WIPO.INT. or EUROPA.EU.</p>	<p>Left mentioned data constitute a sample registration. By transferring the amount indicated, you approve this offer for listing in the TM-Collection – Edition 2012. In case of any changes, kindly inform us by e-mail (info@tm-collection.com). After printing you will receive a complimentary copy of the publication. Above sum is payable in advance, by remitting a cheque, or by money transfer.</p>

Brand owners should disregard notices that do not feature the official seals of the registries in which they have filed, such as the USPTO, WIPO or EUIPO:

USPTO:	WIPO:	EUIPO:
		

Anyone Can Be a Target (Including Your Trademark Lawyers!)

Even our law firm has been the target of these misleading trademark solicitation efforts. Below is a deceptive invoice received by Sullivan:



REGISTER OF PROTECTED PATENTS AND TRADEMARKS
Publication of Protected Patents & Trademarks on the Internet

Phone: 646 369 1419
Fax: 917 791 8728
support@ptmi.us
www.ptmi.us

Keep this for your records

▼ TRADEMARK / PATENT OWNER ADDRESS

Sullivan & Worcester LLP
One Post Office Square
Boston, MA 02109

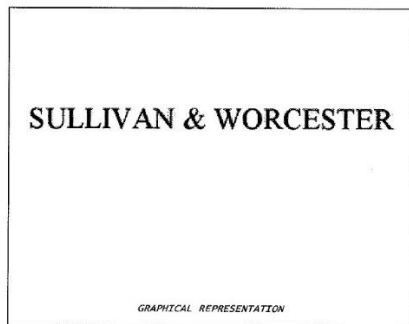
IMPORTANT NOTIFICATION REGARDING YOUR TRADEMARK



PAYMENT FOR	
FILING DATE:	08-25-2015
PTMI REG.#	86736721
MARK TYPE:	Service Mark
REGISTRATION DATE:	04-05-2016

▼ REGISTERED MARK:
SULLIVAN & WORCESTER

MARK DRAWING TYPE:	4
REGISTER:	Principal
REGISTRATION NUMBER:	4932073
CLASSES:	045
PERIOD:	UP TO 2021
AMOUNT:	\$ 765



THE TRADEMARK PUBLICATION PROVIDES THE NAME OF TRADEMARK AND PATENT OWNERS, PRODUCT NAMES ON THE PTMI DATABASE. IT CONTAINS ONLY PAID, REGISTERED TRADEMARKS AND PATENTS WITH THEIR USPTO REGISTRATION NUMBERS AND CLASSES, ALONG WITH THE CURRENT OWNER ADDRESS. PLEASE SEND YOUR PAYMENT IN THE REMITTANCE ENVELOPE IN ORDER TO ENABLE PUBLISHING OF YOUR TRADEMARK OR PATENT LISTED AS SHOWN. YOUR DATA WILL BE PUBLISHED FOR A TERM OF TWO YEARS UPON RECEIPT OF PAYMENT. YOU WILL BE NOTIFIED IN SUFFICIENT TIME TO EXTEND YOUR REGISTRATION. PUBLICATION ON THE TRADEMARK DATABASE REGISTER ENSURES THE REGISTERED PARTY A WORLDWIDE PUBLICATION ON THE INTERNET. THIS PUBLICATION IS AN ELECTIVE SERVICE WHICH NEITHER SUBSTITUTES THE REGISTRATION NOR PROLONGS THE VALIDITY OF THIS TRADEMARK OR PATENT WITH THE USPTO. THE INSTITUTE DOES NOT ASSUME ANY LIABILITY EITHER FOR THE ACCURACY OR COMPLETENESS OF THE REGISTERED INFORMATION OR FOR TRADEMARK OR PATENT PROTECTION. PTMI IS NOT ENDORSED BY THE U.S. GOVERNMENT. CHANGES WILL BE MADE FREE OF CHARGE UPON RECEIPT OF A WRITTEN REQUEST. IF THE TRADEMARK OR PATENT IS PARTIALLY OR ENTIRELY ASSIGNED TO ANOTHER OWNER, THE ASSOCIATION MUST BE INFORMED IN WRITING. PREMATURE CANCELLATION OF PUBLICATION MUST BE REQUESTED IN WRITING.

THE TRADEMARKS AND PATENTS OWNER RETAINS SOLE RESPONSIBILITY FOR THE PROTECTION OF TRADEMARKS AND PATENTS REGISTERED BY THE UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO) AND THE ENFORCEMENT OF THE STATUTORY RIGHTS ASSOCIATED WITH IT.

▼ DO NOT STAPLE, TAPE OR CLIP PAYMENT STUB OR CHECK

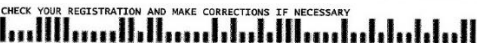
▼ DETACH AND MAIL THIS STUB WITH YOUR PAYMENT

BALANCE DUE \$ 765	PERIOD UP TO 2021	PTMI REG.# 86736721
▼ TRADEMARK / PATENT OWNER ADDRESS		
Sullivan & Worcester LLP One Post Office Square Boston, MA 02109		

PLEASE MAKE CHECKS PAYABLE TO:
PATENT AND TRADEMARK INSTITUTE

INCLUDE THE PTMI REG.# 86736721
ON THE CHECK AND SEND THIS STUB WITH YOUR CHECK IN THE
REMITTANCE ENVELOPE TO:

ACCOUNTING DEPARTMENT #132
1124 FOREST AVE
STATEN ISLAND, NY 10302-2044



CHECK #

This invoice attempts to appear legitimate by including a “Patent and Trademark Institute / PTMI” logo, a bar code, and trademark registration information pertaining specifically to Sullivan. Upon closer inspection, there are key details that reveal this is a misleading and unofficial solicitation:

- The “Patent and Trademark Institute” is not a part of or affiliated with any governmental office, in this case, the USPTO.
- The contact email address and website URL contain the domain “ptmi.us,” instead of the official USPTO domain, “uspto.gov.”

- The payment address is in Staten Island, New York, and not at the USPTO headquarters in Alexandria, Virginia.
- The notice states that PTMI “is an elective service which neither substitutes the registration nor prolongs the validity of this trademark or patent with the USPTO” and “is not endorsed by the U.S. government,” which reveals that PTMI is a private agency rather than an official government office.

Five Tips for Trademark Owners

Here are five tips for dealing with an unexpected notification, solicitation or invoice relating to your trademarks:

1. **Do NOT pay it!** You may feel compelled to respond immediately to these invoices with the intention of preventing unwanted action against your trademark registration or application, but with these dubious scams running unchecked, it is best to refrain from impulsive decision-making.
2. **Evaluate the notice.** Does the solicitation contain any of the red flags discussed above?
3. **Contact your trademark lawyer.** If you have questions about the validity of a trademark solicitation or invoice, do not hesitate to contact your trademark attorney here at Sullivan. As a general rule, for trademark prosecution and maintenance work handled by Sullivan attorneys, all legitimate government fees will be stated on our invoices.
4. **Spread the word.** If you are a member of your company’s legal or marketing team, you should alert other colleagues who might receive these types of notices, especially those who work in the accounting department or are responsible for handling the payment of official notices. Feel free to share this advisory.
5. **File a complaint.** You may wish to file an official complaint with government authorities or consumer protection agencies. For example, the USPTO recommends [filing an online consumer complaint with the Federal Trade Commission \(FTC\)](#). Though the FTC does not investigate complaints on an individual level, widespread submissions could encourage the agency to investigate and ultimately prosecute scammers for their deceptive business practices.

If you have any questions or would like to discuss this Client Alert, please feel free to contact Michael Palmisciano (212.660.3052; mpalmisciano@sullivanlaw.com) or any member of Sullivan’s Trademark Group.

<https://www.sullivanlaw.com/practices-area-Trademarks.html>

Who We Are

We are an international law firm, comfortable with complexity and intensely focused on results. With innovation in our DNA, we attract clients that are visionaries, trailblazers and game changers – those firms willing to push into new markets, create new products, pursue disruptive business models. And we are there for them each step of their journey, giving them confidence to succeed.

We are committed to bringing our best to each client – hands-on, business savvy, straightforward legal advice – a culture that promotes collaboration and diversity of thought. We take great pride that among our clients are enterprises owned and/or led by women and people of color.

At Sullivan, we will recalibrate your expectations what it means to work with a law firm.

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